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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
E0366.70005US00	

Application Number	Filed
09/826,157-Conf. #4012	April 4, 2001

First Named Inventor	
John J. Hart, III	

Art Unit	Examiner
2137	M. J. Pyzocha

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 32,950
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

Signature

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October 2, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 2, 2006

Signature: _____ (Sheila Gravina)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The claims in this application stand rejected under 35 U.S.C. § 101 and 35 U.S.C. § 103. The rejection under 35 U.S.C. § 101 is appropriate for consideration under the Pre-Appeal Brief Conference Program, as established at 1296 *Off. Gaz. Pat. Office* 67 (July 12, 2005) because it is based on a clear error in applying the law.

Rejection under 35 U.S.C. § 101

Clear error in the rejection of claims 133-139 under 35 U.S.C. § 101 is evidenced by the following statements made by the Examiner in rejecting the claims 133-139 in each of three Office Actions:

1. The claims "relate to the arrangement of data on a computer readable medium, which does not constitute statutory material." (Office Action, Jun. 30, 2005, at 3)
2. The "watermarked data does not cause a computer to perform any function, so it is non-functional and therefore non-statutory." (Office Action, Jan. 31, 2006, at 10)
3. The "claimed watermark does not qualify as a data structure as described [in M.P.E.P. 2106 IV.B.1] and is therefore nonfunctional descriptive material, which is non-statutory." (Office Action, May 31, 2006, at 10-11)

The examiner's statements evidence a clear error because they contradict controlling legal precedent, *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994), and misapply the M.P.E.P.

The court in *Lowry* considered claims describing the arrangement of data on a computer-readable medium allowing for more efficient processing of the data. *Id.* at 1851-52. In finding

that the claims in *Lowry* were statutory, the court rejected the contention that the data on a computer-readable medium was unpatentable as printed matter.

The examiner's first reason for the rejection, a blanket statement that claims "relat[ing] to the arrangement of data on a computer readable medium [do] not constitute statutory material," is a clear error of law. *Lowry* demonstrates that claims relating to the arrangement of data – such as a data structure for arranging data on a computer readable medium – can be patentable.

The examiner's second statement, that the "watermarked data does not cause a computer to perform any function, so it is non-functional and therefore non-statutory," is also a clear error of law. Data need not *cause* a computer to perform a function to be functional. *Id.* at 1584. This proposition is clearly illustrated by the data stored on computer disks considered in *Lowry* where the data did not cause a computer to perform any function, yet the *Lowry* court found those claims to be functional and statutory. *Id.*

The examiner's third statement, that the "claimed watermark does not qualify as a data structure as described [in MPEP 2106 IV.B.1] and is therefore nonfunctional descriptive material, which is non-statutory," is a clear error for two reasons. First, it mischaracterizes the claim. Second, it misapplies the M.P.E.P.

Contrary to the Examiner's assertion, the claims do not recite not a watermark, *per se*, but recite multiple types of data (an "identification code" and "title data") stored according to a prescribed pattern ("at a plurality of locations the identification code modulated on the title data with a different modulation scheme...") on a computer-readable medium. Such a structure falls within the M.P.E.P. definition, which states that a data structure is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." M.P.E.P. 2106 IV.B.1.

In more detail, claims 133-139 recite a physical or logical relationship between the title data and the identification code used to form the watermark. That relationship includes a modulation scheme expressly recited in the claims. The data elements, and specifically the relationship between the data elements, is designed to support data manipulation functions, such as allowing the title data to be used without appreciable distortion by the watermark or to allow the identification code to be extracted to authenticate or otherwise identify the source of the title data. Accordingly, the examiner clearly erred in concluding that the claims do not recite a data structure, which is patentable subject matter.

Reference to the Prosecution History

The prosecution history contains further support for Applicant's position, including more detailed application of the M.P.E.P. and the Interim Guidelines for examination of computer related inventions. Relevant statements may be found in the Amendments filed September 22, 2005 (page 8), November 30, 2005 (page 8) and May 1, 2006 (page 8).

Rejection under 35 U.S.C. § 103

Claims 112, 115-117, 122-123, 126-146) are rejected under 35 U.S.C. § 103. While Applicants disagree with the rejection and will contest it on appeal, the disagreement is based in part on the interpretation of our claims and the interpretation of prior art and is thus not appropriate subject matter for the Pre-Appeal Brief Conference Program.

Conclusion

The rejection of claims 133-139 under 35 U.S.C. § 101 is clearly erroneous, and Applicants respectfully request that the panel reverse the rejection.